REMARKS

Upon entry of this Response, claims 1-24 remain pending in the present application. Claims 1, 8, 15, and 22 have been amended. Applicants respectfully request reconsideration of the pending claims in view of the following remarks.

Claims 1-3, 8-10, 15-17, and 22-24 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,714,968 issued to Prust (hereafter "*Prust*") further in view of U.S. Patent No. 5,826,269 issued to Hussey (hereafter "*Hussey*"). A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP §2143.03, In re Rijckaert, 9F.3d 1531, 28 U.S.P.Q 2d 1955, 1956 (Fed. Cir. 1993). In view of the amendments made herein and in view of previous amendments, Applicants assert that the cited references fail to show or suggest all of the elements of claims 1-3, 8-10, 15-17, and 22-24. Accordingly, Applicants request that the rejection of these claims be withdrawn.

To begin, amended claim 1 recites as follows:

> 1.   A document retrieval method, comprising:
> receiving a request email message from a requesting device via a network, the request email message embodying a document request;
> determining from the request email address whether a destination address on the network to which at least one document specified in the document request is to be sent is a forwarding address or an originator address on the network, the originator address being associated with the requesting device, wherein the forwarding address comprises a printer alias associated with a print agent to which a forwarding email message is to be sent, the print agent being configured to orchestrate a printing of the at least one document attached to the email on a printer;
> automatically generating the forwarding email message with the at least one document attached thereto in response to the document request if the at least one document specified in the document request is to be sent to the forwarding address, the forwarding email message being addressed to the forwarding address and the forwarding email message being formatted so as to be recognizable by the print agent that accesses the at least one document attached thereto and orchestrates printing of the document; and
> automatically generating a reply email message with the at least one document attached thereto in response to the document request if the at least one document specified in the document request is to be

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sent to the originator address on the network, the reply email message being addressed to the originator address; and

automatically transmitting either the forwarding email message to the forwarding address or the reply email message to the originator address on the network in response to the request email message.

As set forth above, claim 1 as amended specifies that either the forwarding email message to the third party address or the reply email message to the originator address on the network in response to the request email message.

With respect to claims 1, 8, 15, and 22, the Office Action states as follows:

"However, Prust did not explicitly state determining from the request email address whether a destination address on the network to which at least one document specified in the document request is to be sent is a third party address or an originator address on the network, the originator address being associated with the requesting device; and

automatically generating a forwarding email message with the at least one document attached thereto in response to the document request if the at least one document specified in the document request is to be sent to the third party address, the forwarding email message being addressed to the third party address.

automatically transmitting either the forwarding email message to the third party address or the reply email message to the originator address on the network in response to the request email message .

In an analogous art of email systems, Hussey disclosed and electronic interface for a network server in which clients send email requests and an email response builder generates a response email message, with an attached document, to be issued to the originator of the corresponding email address as well as any other "copied" email accounts originally designated in the "cc:" field (Hussey, col. 11, lines 55-67, col. 12, lines 1-10), which means a message with the requested document is sent to the requester as well as any other third party address specified in the "cc:" field.

Both Prust and Hussey provide emailing systems where users request data. Hussey goes into further detail of the standard functions of the emailing systems.

Therefore it would have been obvious to one in the ordinary skill in the art at the time of the invention to incorporate the basic functionalities of an email system as taught in Hussey into Prust to provide users with a system that processes user requests for shared resources administered by the server (Hussey, col. 3, lines 30-40)." (Office Action, page 3).

Applicants respectfully disagree. Specifically, Applicants assert that *Hussey* fails to show or suggest the concept of determining whether a response to a document

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request is to be transmitted to a forwarding address <u>or</u> an originator address on a network as claimed in amended claim 1. Rather, all addresses to which a response is to be sent are provided in the email request, and no decision need be made as to whether one address or another is to be employed in sending the documents as described in claim 1.

Thus, Hussey describes a conventional approach where are reply email is created and sent to the address in the "TO" filed and any addresses indicated in a "CC" field. However, the present invention involves the creation of systems and methods that make the distinction of whether a reply email is to be sent to the originator address, or a forwarding email is to be sent to a forwarding address. Hussey fails to show or suggest at least this element, as well as other elements as argued in the previous Response filed on 2/1/2005.

In addition, where the structure or text of prior art suggests something other than the instant invention, then it teaches away from the invention, and ultimately, does not suggest the creation of the invention. *Akzo N.V. v U.S. Intern. Trade Comm.*, 808 F.2d 1471, 1 U.S.P.Q 2d (Fed. Cir. 1986), cert. denied, 482 U.S. 909. In this respect, *Hussey* teaches away from the concept of making the determination as to whether an originator address in the "From" field or a specified third party address is to be employed to send a document in response to a received document request. *Hussey* teaches the use of all addresses in the request and avoids the complications of determining specifically where the document is to be sent. Thus, *Hussey* teaches away from making a decision as to whether the originator address is to be employed in a reply or a third party address is to be employed in a forwarding email to send the requested documents to the desired location.

Also, in the Response to Amendment section of the Office Action, the Examiner states the following in response to Applicants' previous arguments:

> "Applicant's arguments with respect to claims 1-24 have been fully considered but they are not persuasive. Applicant's only argument with respect to the amended claims includes the failure of previously applied art to disclose "the concept of determining whether a response to a document request is to be transmitted to a third party address or an originator address on a network as claimed in claim 1."

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In order for a web server to automatically send a response email, the web server must be able to determine what address/addresses should be used for the destination of the response. As shown in the above mapping of the independent claims Husset disclosed a web server determining where the response should be sent based on the contents of the requested email (Hussey, col. 7, lines 20-45). The determination is made as to which email address is the originator address (Hussey, col. 7, lines 25-26), and which addresses are the third party addresses (Hussey, col. 7, lines 27-30)." (Office Action, page 7)

Applicants respectfully disagree with the characterization of the teachings of *Hussey*. In particular, at column 7, line 21-45, *Hussey* states:

"The email processor 32 also receives responses from the SQL request processor 36 corresponding to previously submitted SQL requests. After receiving a response, an email response builder 44 formulates an email response message. <u>The receiver of the email response is designated based upon the identity of the user identified in the sender field of the email request to which the SQL response corresponds. In addition, "cc:" copies are designated in the email response message based upon the contents of the "cc:" field in the email request. In addition, the message may include an attached file which is designated in the response email via an option in the interface to the email transmitter 40.</u> The email generally sends SQL query results as an attached file in a well-known format such as a spreadsheet or ASCII text. The well-known formats allow the mail client 24 to view the query results using standard application software such as a spreadsheet program or text editor.

After building the email response message, the email processor 32 via an invoked extended stored procedure, places the email message in the mail "outbox" associated with the email transmitter 40. The email transmitter 40 sends email responses stored in the mail "outbox" to the electronic mailboxes within the email system 20 corresponding to the users that originally submitted the SQL requests via email as well as any valid cc'd users." (Emphasis Added).

As set forth above, *Hussey* teaches that the receiver of the email response is designated based upon the identity of the user in the sender field and anybody identified in the "cc:" field of the original email. There is no determination made as to whether an originator address or a forwarding address is to be employed to transmit the email. Rather, all addresses are used. The statement that a determination is made as to

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whether an originator address or a forwarding address is to be used is erroneous in light of the plain teachings of *Hussey.*

While it is true that the Examiner has the right to interpret the claim language as broadly as possible, the Examiner cannot legitimately extend the teachings of a given reference beyond what the reference fairly shows or suggests. Claim 1 as amended above specifically recites that a determination be made whether the destination address is to be the original senders address or originator address on the network of a forwarding address. As set forth in claim 1, a reply or forwarding email is not sent to both addresses, where only one of those ultimately receives the email sent in response to the request.

This reflects the fact that the requesting device might be a portable device that does not include the computing power or memory capacity to hold the attached document or to render the document or otherwise process a document in some manner. Thus, the user may wish to send the documents to the forwarding address rather than receiving the document back at the portable device to prevent an attempt to store the attached documents that are included in the reply email on the device. The fact that either the originator address or the forwarding address may be specified to which the document retrieved is to be sent provides a distinct advantage in this respect.

In addition, claim 1, has been amended so as to recite that the forwarding address comprises a printer alias associated with a print agent to which the forwarding e-mail message is sent, where the print agent is configured to orchestrate a printing of the document attached to the email on a printer. Also, the forwarding email address generated in response to the request is formatted so as to be recognizable by the print agent that accesses the document thereto and orchestrates the printing of the document. Applicants respectfully assert that the cited combination of references fail to show or suggest at least these additional elements added to claim 1 in addition to the reasons given above.

In view of the foregoing, Applicants request that the rejection of claim 1 be withdrawn. In addition, Applicants request that the rejection of claims 8, 15, and 22 be withdrawn for the same reasons discussed above with reference to claim 1. Also,

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Applicants request that the rejection of claims 2, 3, 9, 10, 16, 17, 23, and 24 be withdrawn as depending from claims 1, 8, 15, or 22.

In addition, claims 4, 11, and 18 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Prust* in view of *Hussey* and further in view of U.S. Patent No. 6,084,952 issued to Beerman, Jr., et al. (hereafter *"Beerman"*). A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. <u>MPEP</u> §2143.03, <u>In re Rijckaert</u>, 9F.3d 1531, 28 U.S.P.Q 2d 1955, 1956 (Fed. Cir. 1993). Applicants assert that the cited combination of *Prust, Hussey* and *Beerman* fails to show or suggest each of the elements of claims 4, 11, and 18 as depending from claims 1, 8, and 15. Accordingly, Applicants request that the rejection of claims 4, 11, and 18 be withdrawn for the same reasons described above with respect to claims 1, 8, and 15.

Next, claims 5, 12, and 19 have been rejected under rejected under 35 U.S.C. §103(a) as being unpatentable over *Prust* in view of International Patent Publication No. WO 01/33874 by Cho, et al. (hereafter *"Cho"*). Applicants respectfully assert that the cited combination of *Prust* and *Cho* fails to show or suggest each of the elements of claims 5, 12, and 19, as depending from claims 1, 8, and 15 for the reasons described above. Accordingly, Applicants request that the rejection of claims 5, 12, and 19 be withdrawn as depending from claims 1, 8, and 15.

Next, claims 6, 7, 13, 14, 20, and 21 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Prust, Cho,* and U.S. Patent No. 6,212,268 issued to Nielsen (hereafter *"Nielsen"*). Applicants assert that the cited combination of *Prust, Cho* and *Nielsen* fail to show each of the elements of claim 6, 7, 13, 14, 20, and 21 as depending from claims 1, 8, or 15. Accordingly, Applicants request that the rejection of claim 6, 7, 13, 14, 20, and 21 be withdrawn for the same reasons described above with respect to claim 1, 8, and 15.
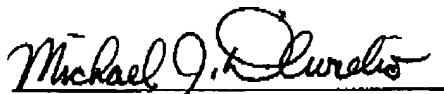
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CONCLUSION

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding this response, the Examiner is encouraged to telephone the undersigned counsel of Applicants.

Respectfully submitted,

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